

REMARKS

By this amendment, claims 1-10, 13-15, and 21-27 are pending, in which claim 16 is canceled without prejudice or disclaimer by this amendment, claims 13-15 are withdrawn from consideration, claim 1 is currently amended, and claim 27 is newly presented. No new matter is introduced.

The Final Office Action mailed August 5, 2010 rejected claims 1-10, and 21-26 under the first paragraph of 35 U.S.C. § 112 as failing to comply with the enablement requirement, claims 1-10, and 21-23 under 35 U.S.C. § 102(b) as anticipated by *Tatsuta et al.* (US Pub. 2002/0125318) (Tatsuta), claim 24 as unpatentable under 35 U.S.C. § 103(a) based on Tatsuta as evidenced by applicant's specification or by *Bloomfield* (US Pub. 2002/0028704) (Bloomfield), claim 25 as unpatentable under 35 U.S.C. § 103(a) based on Tatsuta in view of Dark Age of Camelot Shines by Royce Brainard (website game review article, 6/30/2004 edition) (Dark Age), and claim 26 as unpatentable under 35 U.S.C. § 103(a) based on Tatsuta as supported by applicant's specification, or in view of Bloomfield.

Claims 1-10, and 21-26 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

The Examiner alleged that “with the at least one processor, cause the apparatus to perform at least the following, associate each one of a plurality of device configurations based, at least in part, on one or more capabilities of a device, with a respective game configuration” of claims 1-10 and 21-26 fails to comply with the enablement requirement stating that “Applicant's invention fails to disclose how a processor can determine what the real world capability of a

device is and then associate it with a game configuration.” This rejection is respectfully traversed.

“A patent is not a scientific treatise, but a document that presumes a readership skilled in the field of the invention.” *Ajinomoto Co. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1347 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 1019 (2001) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556 (Fed. Cir. 1983) (holding that “[p]atents, however, are written to enable those skilled in the art to practice the invention, not the public”), *cert. denied*, 469 U.S. 851 (1984)). Therefore, Applicant need only describe the functional aspects and the execution of those aspects by, for example, a device.

The recited claim features have been amended to recite “with the at least one processor, cause the apparatus to perform at least the following, associate each one of a plurality of device configurations based, at least in part, on one or more hardware components with associated functional capabilities of a device, with a respective game configuration” Support for the claim features is located throughout the Specification, for example, the data structure in original claim 1 as well as paragraphs [0031]-[0035], [0044], and [0045]. Clearly the claim feature is supported by the Specification because even the Examiner can readily “determine what the real world capability of a device is and then associate it with a game configuration” because in the Examiner’s rejection, the Examiner recites “it will be interpreted that the capabilities of a device, are capabilities that was programmed, or information stored onto the device.” Office Action, pages 2-3. Therefore, the Examiner’s rejection is improper and withdrawal of the rejection is solicited.

With respect to claim 6, the Examiner alleged that “[a]pplicant’s specification fails to disclose that the apparatus is further caused to update the device configuration.” Office Action,

page 4. However, this feature is clearly described throughout the Specification, for example, at original claim 6 and paragraph [0056] stating “updates the game configuration of a client device when the device configuration for that client device is updated” as well as paragraph [0044]. Therefore, the Examiner’s rejection is improper and withdrawal of the rejection is solicited.

Claims 1-10, and 21-23 were rejected under 35 U.S.C. § 102(b) as anticipated by Tatsuta.

In the statement of the rejection the Examiner asserted that Tatsuta identically discloses the claimed inventions. This rejection is respectfully traversed.

Applicant stresses that the factual determination of lack of novelty under 35 U.S.C. §102(b) requires the identical disclosure in a single reference of each element of a claimed invention, as those elements are set forth in the claims, such that the claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Therasense, Inc. v. Beckton, Dickinson and Company*, 593 F.3d 1289 (Fed. Cir. 2010); *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1308, (Fed. Cir. 2008); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002); *Candt Tech Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344 (Fed. Cir. 2001). Further, as a matter of procedural due process of law, the Examiner is required to specifically identify where in an applied reference is alleged to disclose each and every feature of a claimed invention, particularly when such is not apparent. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). Moreover, there are many fundamental differences between the claimed inventions and

Tatsuta that scotch the factual determination that Tatsuta identically discloses, or even remotely suggests, the claimed inventions.

Specifically, claim 1 recites, *inter alia*: “associate each one of a plurality of device configurations based, at least in part, on one or more **hardware components with associated functional capabilities of a device**, with a respective game configuration, wherein each game configuration differently specifies one or more parameters of a game.” (Emphasis added). These claim features are neither disclosed nor suggested by Tatsuta.

Examples of such hardware components include a camera, a flashlight, a vibration maker, etc. as described in paragraph [0035] of the Specification. The Examiner asserts that paragraph [0165] of Tatsuta discloses the claim feature. Paragraph [0165] recites (emphasis added):

If the recording medium 400, or the playing card, has an oblong rectangular profile, the graphic display region 431 is arranged in the upper half of the card or in an upper half area larger than a half of the entire surface area of the card, and a character image of an animal, a person or an imaginary monster may be printed there. **The kind, design or pattern of the character image printed in the graphic display area 431 may vary from card to card in order to represent the characteristic of the playing card. It may be an image of a character** (a character of the protagonist, a character of the party or the adversary or any character whose image can be an object of collection) that appears on the game screen when the **game program stored in the program ROM 201 of the application program storing cartridge 200 is executed**. A number of such playing cards (e. g., 30 to 40 cards) may be collected into a set (which is referred to as a "starter kit"), each carrying, with arbitrary probability, an image of a funny or cute character that is an object of collection, and put up for sale with or without the code reading apparatus main body 100 and application program storing cartridge 200. A set of duplicates of a small number of different cards (which is referred to as "expansion pack") may also be put up for sale. When the code reading apparatus main body 100 and the application program storing cartridge 200 are provided separately, the starter kit may be sold with the application program storing cartridge 200.

However, Tatsuta makes no mention of any “hardware components with associated functional capabilities of a device” being utilized as a basis for device configurations that are

associated with respective game configurations. In contrast, Tatsuta discloses a “code reading apparatus, entertainment system and recording medium” wherein “code reading apparatus main body optically **reads a code from a recording medium**, recording it as optically readable code, and stores the outcome of the reading operation and the parameters acquired during the reading operation in the data RAM of an application **program storing cartridge.**” (Emphasis added). Further, in Tatsuta, paragraph [0105], “multi-value image information, the binarized image information, the code position/shape information, the code data and the restored information” refers to all data read from a recording medium. Such a recording medium can contain code or data (e.g., an image) that can be read and then transferred to the game cartridge or ROM to modify existing game software. Tatsuta paragraph [0174]. However, the cards of Tatsuta are merely being utilized as memory, while the claimed features recite “associate each one of a plurality of device configurations based, at least in part, on one or more **hardware components with associated functional capabilities** of a device, with a respective game configuration, wherein each game configuration differently specifies one or more parameters of a game.” (Emphasis added). None of the cards of Tatsuta are utilized to associate hardware components with associated functional capabilities of a device to respective game configurations.

The above argued functionally significant differences between the claimed method, apparatus, and system and those disclosed by Tatsuta undermine the factual determination that Tatsuta discloses a method, apparatus, or system identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Applicant, therefore, submits that the imposed rejection of claims 1-10 and 21-23 under U.S.C.

§102(b) for anticipation predicated upon Tatsuta is not factually viable and, hence, solicit withdrawal thereof.

Claim 24 was rejected under 35 U.S.C. § 103(a) based on Tatsuta as evidenced by Applicant's specification or by Bloomfield.

This rejection is respectfully traversed.

Claim 24 is dependent from claim 1. Applicant incorporates, herein, the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102(b) for anticipation predicated upon predicated upon Tatsuta. Bloomfield does not cure the deficiencies of Tatsuta. Further, the Examiner's attempted reliance on the Applicant's Specification is improper. Accordingly, even if the applied references were combined as proposed by the Examiner, and Applicant does not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *See Uniroyal, Inc. v. Rudkin-Wiley Corp., supra.* Thus, it is respectfully requested that the rejection of claim 24 be withdrawn.

Claim 25 was rejected under 35 U.S.C. § 103(a) based on Tatsuta in view of Dark Age.

This rejection is respectfully traversed.

Claim 25 is dependent from claim 1. Applicant incorporates, herein, the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102(b) for anticipation predicated upon predicated upon Tatsuta. Dark Age does not cure the deficiencies of Tatsuta. Accordingly, even if the applied references were combined as proposed by the Examiner, and Applicant does not agree that the requisite fact-based motivation has been

established, the claimed invention would not result. *See Uniroyal, Inc. v. Rudkin-Wiley Corp., supra.* Thus, it is respectfully requested that the rejection of claim 25 be withdrawn.

Claim 26 was rejected under 35 U.S.C. § 103(a) based on Tatsuta as supported by Applicant's specification, or in view of Bloomfield, further in view of Dark Age.

This rejection is respectfully traversed.

Claim 26 is dependent from claim 1. Applicant incorporates, herein, the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102(b) for anticipation predicated upon predicated upon Tatsuta. Bloomfield and Dark Age do not cure the deficiencies of Tatsuta. Further, the Examiner's attempted reliance on the Applicant's Specification is improper. Accordingly, even if the applied references were combined as proposed by the Examiner, and Applicant does not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *See Uniroyal, Inc. v. Rudkin-Wiley Corp., supra.* Thus, it is respectfully requested that the rejection of claim 26 be withdrawn.

New claim 27.

Claim 27 is new and is allowable for at least the reasons set forth for claim 1 from which it depends.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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Date

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